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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,601	09/29/2003	Yousuke Yoneda	1419.1061C	8535

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EXAMINER	
HYLINSKI, ALYSSA MARIE	

ART UNIT	PAPER NUMBER
3711	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/671,601	YONEDA, YOUSUKE	
	Examiner	Art Unit	
	Alyssa M. Hylinski	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-8,21 and 23-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-8,21 and 23-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/21/09 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "the shaft connected to the chassis" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 16, 21, 23-25, 27-31 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato (1-172894) and Balthazor (3083499). Minato discloses

a suspension for a running toy (page 1 paragraph 2) having first and second turning members (23,24), which turn first and second wheels (27,28) about first and second vertical shafts (23b, 24b) movably received by a chassis or frame member (20, 29) of the toy (Fig. 3). A member (34) connects the first and second turning members and forms a turning device (page 9 paragraph 2). A leaf spring (36) located on top of the chassis has side portions that contact upper portions of the first and second shafts as they project from the top of the chassis (Fig. 2) and subjects them to a downward biasing force caused by elastically deforming the leaf spring (page 11 second paragraph). The suspension system is for a remote control toy car (page 1 paragraph 2). The leaf spring further comprises a projecting portion or shaft (37) formed at a middle portion thereof (Fig. 3) in order to attach the leaf spring within a cleft in the frame (Fig. 2). The cleft is formed by the hollow or unfilled space between protuberances or loops on a flat portion of the frame (Fig. 3). The shaft and leaf spring are formed as a unitary member (Fig. 3). The suspension system allows either wheel to move in a vertical direction while being biased by the biasing member or leaf spring (Fig. 4b). Minato discloses the basic inventive concept, substantially as claimed, with the exception of the recess portion being formed in the flat portion of the chassis. Balthazor discloses that it is well known in the toy art to hold a spring member in place by means of a recess (46) formed within a flat portion of a chassis (Figs. 2-5). Since both references teach configurations for retaining a biasing member or leaf spring, it would have been obvious to one skilled in the art to substitute one method for the other to achieve the predictable result of holding a spring member in place. Furthermore, the

examiner notes that it is extremely well known to hold elements within recesses for the known purpose of positioning and supporting an element.

6. Claims 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato, Balthazor and Perryman (GB 1095490). Minato discloses the basic inventive concept substantially as claimed with the exception of the leaf spring being made of metal or plastic. Perryman discloses a leaf spring used in the suspension system of a toy car made of plastic or steel (page 2 lines 122-129). It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Perryman to use metal or plastic in a leaf spring since it is elastically deformable and usable as a biasing member. Furthermore, the mere selection of known materials such as metal and plastic on the basis of suitability for the intended use would be entirely obvious. See *in re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Minato with metal or plastic in order to use known materials suitable for the intended use.

7. Claims 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato, Balthazor and Booher (4893832). The references disclose the basic inventive concept as described above, with the exception of the leaf spring being configured to have one side of the leaf spring bend in response to one wheel being moved up and allowing both side portions to bend if both wheels are moved up. Booher discloses a suspension for a vehicle having a leaf spring configured to allow either one side or both sides to bend in response to movement of the wheels (Fig. 7). It would have been obvious to one of ordinary skill in the art from the teaching of Booher to configure the

leaf spring in this way in order to vary the characteristics of the suspension system as desired (column 4 lines 56-60). Furthermore, since Booher discloses a leaf spring configuration usable in a suspension system for a vehicle that would be an art-recognized equivalent to the leaf spring as disclosed by the references, one of ordinary skill in the art would have found it obvious to substitute one for the other.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-3, 6-8, 16, 21 and 23-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 7 of U.S. Patent No. 6656011 in view of Minato (1-172894). Patent No. 6656011 discloses a running toy with a suspension having first and second turning members which turn respective first and second wheels connected thereto to respective first and second

shafts of the turning members, a member which connects the first and second members for forming a turning device, a detachable leaf spring of metal or plastic located on a top surface at a middle portion thereof, wherein upper portions of the shafts project from the top of the chassis and are in contact with the leaf spring to be subject to downward biasing force caused by elastically deforming the leaf spring and the top of the chassis includes an upper portion in which is formed a recess for receiving the middle portion of the spring. Patent No. 6656011 discloses the basic inventive concept with the exception of upper portion of the chassis being flat and the leaf spring being formed as a unitary member having a shaft. Minato discloses a suspension for a running toy having a flat upper chassis to which is held a unitary leaf spring with shaft (Figs. 2 & 3). It would have been obvious to one of ordinary skill in the art to have the upper portion of the chassis be flat and to have the leaf spring integrally formed with a shaft since such a modification would have involved a mere change in the shape of a component. Changes in shape are generally held to be within the level of ordinary skill in the art. *See In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).*

Response to Arguments

10. Applicant's arguments filed 1/21/09 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the spring being located above the upper chassis member) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. In regard to applicant's argument that there is no specific suggestion or teaching in the references to combine the prior art, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20 (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396)>

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH
/Gene Kim/
Supervisory Patent Examiner, Art Unit 3711